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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/121,211 07/23/98 SHINOHARA

T B0801/7116

EXAMINER

HM12/0426

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ROMED, D

ART UNIT

PAPER NUMBER

1647

17

DATE MAILED:

04/26/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Advisory ActionApplication No.
09/121,211Applicant(s)
Shinohara et al.Examiner
David RomeoArt Unit
1647

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 29 Mar 2001 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ In view of the early submission of the proposed reply (within two months as set forth in MPEP § 706.07 (f)), the period for reply expires on the mailing date of this Advisory Action, OR continues to run from the mailing date of the final rejection, whichever is later. In no event, however, will the statutory period for the reply expire later than SIX MONTHS from the mailing date of the final rejection.

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will be entered upon the timely submission of a Notice of Appeal and Appeal Brief with requisite fees.
3. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search. (See NOTE below);
- (b) ☐ they raise the issue of new matter. (See NOTE below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: See the Attachment at paragraph 1.

4. ☐ Applicant's reply has overcome the following rejection(s):

5. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claim(s).
6. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See the attachment at paragraph 2.
7. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
8. ☒ For purposes of Appeal, the status of the claim(s) is as follows (see attached written explanation, if any):
Claim(s) allowed: none
Claim(s) objected to: 2 and 3
Claim(s) rejected: 1, 4-11, and 26
9. ☐ The proposed drawing correction filed on _____ a) ☐ has b) ☐ has not been approved by the Examiner.
10. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
11. ☒ Other: See the attachment at paragraph 3.

DAVID ROMEO
PRIMARY EXAMINER
ART UNIT 1647

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Attachment to Paper No. 17 (Advisory Action)

1. The proposed amendment(s) will not be entered because they raise new issues that would require further consideration and/or search. The proposed amendment also includes limitations not previously examined.

5 2. The affidavit, exhibit or request for reconsideration has been considered but does NOT place the application in condition for allowance because:

Claims 1, 8, 10, 26 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession
10 of the claimed invention. Applicants' arguments have been fully considered but they are not persuasive. Example 9 of the revised interim written description guidelines training materials is clearly distinguishable from the instant application because example 9 is directed to a situation wherein the specification disclosed a single cDNA (SEQ ID NO:1) which encoded a protein that bound to a dopamine receptor and stimulated adenylate cyclase activity. The specification
15 included an example wherein the complement of SEQ ID NO: 1 was used under highly stringent hybridization conditions (6XSSC and 65 degrees Celsius) for the isolation of cDNAs that encoded proteins that bound to dopamine receptor and stimulated adenylate cyclase activity. The hybridizing nucleic acids were not sequenced. They were expressed and several were shown to

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5 encode proteins that bind to a dopamine receptor and stimulate adenylate cyclase activity. These sequences may or may not be the same as SEQ ID NO: 1. In the instant application, unlike example 9, the specification does not include an example wherein other cDNAs that were isolated and that encoded proteins that stimulated protein synthesis in an epithelial cell. Furthermore, the instant specification at page 49, lines 6-8, only describes results indicating that LEDGF regulated the synthesis and accumulation of several proteins in mouse LECs, whereas the claims are directed to the inducing protein synthesis in any and all epithelial cells, which the specification does not describe.

10 Claims 1, 8, 10, 26 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a nucleic acid molecule comprising the nucleotide sequence of SEQ ID NO:1, does not reasonably provide enablement for nucleic acid molecules which hybridize to SEQ ID NO:1 and encode a lens epithelial cell derived growth factor polypeptide, or for a nucleic acid molecule comprising deletions, additions and substitutions of nucleic acid molecules which hybridize to SEQ ID NO:1 and encode a respective lens epithelial cell derived growth factor polypeptide, or for a fragment of SEQ ID NO:13 without regard to the structure and/or function thereof, or for an agent that binds a nucleic acid molecule. Applicants' arguments have been fully considered but they are not persuasive. Applicants' arguments are directed to the proposed amended claims and those amendments have not been entered.

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considered but they are not persuasive. Applicants' arguments are directed to the proposed amended claims and those amendments have not been entered.

Claims 4-7, 9-11 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. Applicants' arguments have been fully considered but they are not persuasive. Applicants' arguments are directed to the proposed amended claims and those amendments have not been entered.

Claims 4-7, 9-11 are rejected under 35 U.S.C. § 112, second paragraph, because they refer to GenBank accession numbers. Applicants' arguments have been fully considered but they are not persuasive. Applicants' arguments are directed to the proposed amended claims and those amendments have not been entered.

3. Other: Claims 12-22, 29, 31, 34, 35, 44, 45, 47, 49, 52, 55, 56, 58, 61, 64, 70 are withdrawn from consideration. Claims 1-22, 26, 29, 31, 34, 35, 44, 45, 47, 49, 52, 55, 56, 58, 61, 64, 70 are subject to restriction or election requirement.

ANY INQUIRY CONCERNING THIS COMMUNICATION OR EARLIER COMMUNICATIONS FROM THE EXAMINER SHOULD BE DIRECTED TO DAVID S. ROMEO WHOSE TELEPHONE NUMBER IS (703) 305-4050. THE EXAMINER CAN NORMALLY BE REACHED ON MONDAY THROUGH FRIDAY FROM 6:45 A.M. TO 3:15 P.M. IF ATTEMPTS TO REACH THE EXAMINER BY TELEPHONE ARE UNSUCCESSFUL, THE EXAMINER'S SUPERVISOR, GARY KUNZ, CAN BE REACHED ON (703) 308-4623. OFFICIAL PAPERS FILED BY FAX SHOULD BE DIRECTED TO (703) 308-4242. FAXED DRAFT OR INFORMAL COMMUNICATIONS SHOULD BE DIRECTED TO THE EXAMINER AT (703) 308-0294. ANY INQUIRY OF A GENERAL NATURE OR RELATING TO THE STATUS OF THIS APPLICATION OR PROCEEDING SHOULD BE DIRECTED TO THE GROUP RECEPTIONIST WHOSE TELEPHONE NUMBER IS (703) 308-0196.


DAVID ROMEO
PRIMARY EXAMINER
ART UNIT 1647

APRIL 25, 2001

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